

REMARKS

Claims 12-27 are pending in the present application. Claims 9-11 are canceled without prejudice. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 121

The Office Action requires a restriction to one of the following sets of claims:

- I. Claims 9-11;
- II. Claims 12-19;
- III. Claims 20-27.

In response to the Restriction Requirement, Applicant provisionally elects invention II, claims 12-19, with traverse.

Claims 9-11, to non-elected invention I, are hereby canceled without prejudice.

Applicant respectfully traverses the restriction of Groups II and III. The MPEP states at section 803 the following:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

[Emphasis added.]

Hence, there must be a "serious burden" on the examiner if restriction is not required in order to impose restriction on an application. Guidelines for restricting applications are also stated in section 803, and includes the following:

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases.... For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP sec. 808.02.

In the present case, Examiner has required restriction of Groups II and III of the present application without providing reasons or examples to support the conclusion that a serious burden will be imposed on the Examiner if restriction is not required. Examiner refers to the groups as patentably distinct at page 2 of the Office Action of 05.14.03.

In support, Applicant respectfully submits that Groups II and III respectively claim a method and a system for forming metal pointed tips for use in a thermoelectric device, and that examination of the two groups in a single application would not impose a serious burden on the Examiner. Further, MPEP at section 808.02 gives guidelines for imposing restriction of distinct inventions, stating (in part),

...the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

- (A) Separate classification thereof:...
- (B) A separate status in the art when they are classified together:...
- (C) A different field of search:....

Since both Groups II and III include claims to forming metal pointed tips for use in a thermoelectric device, it is respectfully submitted that no serious burden would be imposed on Examiner if the two groups are examined together.

It is therefore respectfully urged that the subject application be reconsidered.

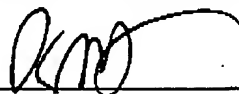
II. Telephone Interview of 06.09.03

Applicant respectfully refers Examiner Kielin to the telephone interview of 06.09.03. In that interview, though no formal agreement was reached, Examiner indicated his willingness to consider examining groups II and III together since they both involve forming metal tips for forming thermoelectric coolers.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 6.10.03

Respectfully submitted,



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